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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/719,639	09/25/96	MATTAWAY	S N0003/7013

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WM02/1220

EXAMINER

HSU, A

ART UNIT	PAPER NUMBER
2662	18

DATE MAILED:

12/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

CM

**Office Action Summary**

Application No.

08/719,639

Applicant(s)

MATTAWAY ET AL.

Examiner

Alpus H. Hsu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 27 September 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_.

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1. In the entire specification, the applicant is requested to update the status from time to time for all of the listed related co-pending applications.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>®</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 12, 23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberlander et al. (of record).

Oberlander et al. discloses a method, apparatus and computer program product for selectively alerting user of an incoming communication over a computer network (101, 104 and 106) by receiving an incoming communication containing an information profile (Fig. 3) identifying the source of the incoming communication, and responding to the incoming

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communication in accordance with the identity of the source, providing source physical address or telephone number in the information profile (see Figs. 1 and 5, col. 3, line 33 to col. 5, line 24, col. 8, lines 15-50) as in claims 1, 12, 23 and 31. But Oberlander fails to disclose the feature of including, in addition to the source telephone number, any of the first name, last name, street, apartment, city, state, country, postal code, facsimile or company data associated with the source in the user info field of the information profile. However, Oberlander et al. does disclose the possibility of adopting any other categories of information in the incoming communication to accommodate the needs of a particular application (see col. 5, lines 12-15). Therefore, if the particular application involves communications between users requiring the user's personal profile information, it is inherently to include the first name, last name, street, apartment, city, state, country, postal code, facsimile or company data associated with the user. The examiner takes Official Notice that the concept and advantage of providing any of the first name, last name, street, apartment, city, state, country, postal code, facsimile or company data associated with the source in the user info field of the information profile in addition to the source telephone number are well known and expected in the art. It would have been obvious to include any of the first name, last name, street, apartment, city, state, country, postal code, facsimile or company data associated with the source in the user info field of the information profile in addition to the source telephone number provided from the teaching of Oberlander et al. since to provide additional data associated with the source in the data transmitted is well known to provide user profile update in the system database and to provide further detail information

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regarding source at the destination end of the communication system for improving personalized end-to-end user communication.

4. Claims 2-11, 13-22, 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberlander et al. in view of Blonder et al. (both of records).

Considering claims 2-8, 13-19, 24-30, Oberlander et al. does not teach the generation of a notification signal, nor its association with the information profile. Blonder et al. teaches a method and apparatus for using a communication system to alert a transaction user by including a database for receiving information and storing a profile, including a processor for retrieving the profile from the database and comparing information associated with the profile, and a network, over which a notification signal is transmitted (see Fig. 1, col. 5, lines 33-47, col. 7, lines 21-39). It would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the invention of Oberlander et al. to include the notification signal found in the teaching of Blonder et al. because of the advantage that it allows the system to be equipped with device for notifying the user and accommodates a wide variety of communication platforms, and allows the user to better control reception of incoming messages to best suit their own particular needs (see Oberlander et al., col. 2, lines 11-16).

Considering claims 9-11, 20-22, the combination of system and method provided from the teaching of Oberlander et al. in view of Blonder et al. fails to teach a notification signal as being an audio signal, a graphic image signal or a haptic sensor signal. The examiner takes Official Notice that the concept and the advantage of providing a notification signal which includes an audio signal, a graphic image signal or a haptic sensor signal are well known and

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expected in the art. It would have been obvious to include audio signal, graphic image signal or haptic sensor signal to the notification signal provided from the teaching of Oberlander et al. in view of Blonder et al. since the audio, graphic image signal and haptic sensor signal are known to provide the user with auditory, visual and sensible feedback to the communication system for user alerting purpose.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gordon is additionally cited to show the feature of Internet activity involving voice mail, E-mail, facsimile and other message types in communications network utilizing information fields within the data packets transmitted similar to the claimed invention.

Bobo, II is additionally cited to show the feature of message storage and retrieval utilizing address signal in the incoming message via Internet similar to the claimed invention.

6. Applicant's arguments filed September 27, 2000 have been fully considered but they are not persuasive.

In the remark, the applicant is mainly arguing that the Official Notices taken by the examiner were improper and based on the personal knowledge of the examiner. The examiner disagrees for the following reasoning:

First, in all claims, it is the feature of "information profile identifying the source of the incoming communication, the information profile including any of the first name, last name, street, apartment, city, state, country, postal code, facsimile or company data associated with the source in the user field" being claimed. The Oberlander reference does indeed disclose some or

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part of the claimed information profile which is the source address or telephone number, which clear meets the claimed limitation.

Second, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a communication over a packet-switched network instead of a circuit switched system as in Oberlander) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Third, the use of the first name, last name, street, apartment, city, state, country, postal code, facsimile or company data associated with the source in the user info field of the information profile in addition to the source telephone number and the use of notification signal which includes an audio signal, a graphic image signal or a haptic sensor signal are well known and expected in the art. See Gerace in U.S. Patent No. 5,848,396 and Frisken Gibson in U.S. Patent No. 5,548,694 (not provided) for the teaching of the above schemes.

Based on the above reasoning, the examiner believes that all rejections under 103(a) should be sustained.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (703)305-4377. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (703)305-4744. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-9051 for regular communications and (703)305-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.

AHH   
December 15, 2000

  
Alpus H. Hsu  
Primary Examiner  
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